



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/782,412	02/13/2001	Gary P. Mousseau	1400-1072 D5	3123

54120 7590 10/29/2009

RESEARCH IN MOTION
ATTN: GLENDA WOLFE
BUILDING 6, BRAZOS EAST, SUITE 100
5000 RIVERSIDE DRIVE
IRVING, TX 75039

EXAMINER

STRANGE, AARON N

ART UNIT	PAPER NUMBER
----------	--------------

2448

NOTIFICATION DATE	DELIVERY MODE
-------------------	---------------

10/29/2009

ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

portfolioprossecution@rim.com

Office Action Summary	Application No.		Applicant(s)	
	09/782,412		MOUSSEAU ET AL.	
	Examiner		Art Unit	
	AARON STRANGE		2448	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 16 July 2009.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 67-78 and 97-107 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 67-78 and 97-107 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>20091015</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Terminal Disclaimer

1. The terminal disclaimer filed on 7/16/09 disclaiming the terminal portion of any patent granted on this application which would extend beyond the expiration date of US Application No. 10/671,162 has been reviewed and is accepted. The terminal disclaimer has been recorded.

Response to Arguments

2. Applicant's arguments with respect to all pending claims have been considered but are moot in view of the new ground(s) of rejection.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 65, 67-70, 89, 97 and 99 are rejected under 35 U.S.C. 103(a) as being unpatentable over Eggleston et al. (US 5,958,006) in view of Hall et al. (US 5,826,023).

5. With regard to independent claim 65, Eggleston disclosed a method of redirecting e-mail messages and message attachments to a user of a mobile data

Art Unit: 2448

communication device that is associated with a host system and communicates therewith, the method comprising:

receiving a data item (email) for the user at the host system (server 115) from a sender, the data item including a message attachment (e.g. email message with attachment, Col 8, lines 30-37) and an e-mail message addressed to a first address identifying a mailbox that is viewable by the user (mailbox is user's personal email post office box)(col. 6, ll. 59-6);

redirecting at least a portion (e.g. when the user has implemented a filter and only part of the message is sent to the user, see inter alia Col 3, lines 23-26 and Col 10, lines 10-32) of the e-mail message to a second address (wireless network address) associated with the mobile data communication device via a wireless network (messages, or portions thereof, are sent to the remote device at the network address of the device)(col. 4, ll. 29-35);

receiving a first command message from the mobile data communication device at the host system requesting more of the data item (i.e. sends the request after receiving partial or summary data for more of the message or all of the message, see inter alia Col 3, lines 29-34 or Col 10, line 57 – Col 11, line 4); and

redirecting the message attachment from the host system to the mobile data communication device via the wireless network in response to first command message (i.e. when the user requests all of the message or full transfer of the message, the attachment will also be sent to the user's mobile device, again see inter alia Col 3, lines 29-34 or Col 10, line 57 – Col 11, line 4).

However, Eggleston fails to specifically disclose that the message is redirected in an outer envelope for transmission via the wireless network, a technique known in the art as tunneling.

Hall discloses a similar system for transporting an electronic mail message across different network types (Abstract). Hall teaches encapsulating an electronic mail created for transmission via a first network in outer envelopes for transmission over a second type of network (col. 2, l. 45 to col. 3, l. 8). This would have been an advantageous addition to the system disclosed by Eggleston since it would have allowed the e-mail and reply messages to be created in the same format and simply tunneled over the wireless network using an outer envelope. This would have advantageously eliminated the need to convert messages between formats used by different networks.

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to transmit the messages over the wireless network using an outer envelope to eliminate the need to convert message formats for communication over different network types.

6. With regard to claim 67, Eggleston disclosed:

configuring one or more redirection events at the host system (e.g. user sets up a filter, see inter alia Col 8, lines 14-55);

detecting that a redirection event has occurred at the host system (i.e. an email passes the filter criteria) and generating a redirection trigger (required internally in the

Art Unit: 2448

system such that the system invokes the process or procedure to actually forward the message); and

In response to the redirection trigger, redirecting at least a portion of the e-mail message from the host system to the mobile data communication device (i.e. forwarding the message when it passes the filter criteria).

7. With regard to claims 68 and 69, Eggleston disclosed the external redirection event is a message from the mobile data communication device to start the redirection step (i.e. user enables the filters from the mobile device, Col 9, lines 32-43). Eggleston also disclosed the internal event includes a calendar alarm (calendar activates a filter profile, Col 9, lines 42-43).

8. With regard to claim 70, Eggleston disclosed the mobile data communication device is one of a hand-held wireless paging computer, a wirelessly-enabled palm-top computer, a mobile telephone with data message capabilities and a wirelessly-enabled laptop computer (Col 4, lines 11-13).

9. Claims 97 and 99 are rejected under the same rationale as claims 65 and 70, since they recite substantially identical subject matter. Any differences between the claims do not result in patentably distinct claims and all of the limitations are taught by the above cited art.

Art Unit: 2448

10. Claims 71-73 and 100-102 are rejected under 35 U.S.C. 103(a) as being unpatentable over Eggleston et al. (US 5,958,006) in view of Hall et al. (US 5,826,023) further in view of Official Notice.

11. With regard to claims 71-73, while the system disclosed by Eggleston in view of Hall shows substantial features of the claimed invention (discussed above), it fails to disclose that the attachment is one of a word processing, audio or video attachment, or whether the attachment is one that can be processed by the mobile device.

The Examiner takes Official Notice that word processing files, audio files, and video files were all old and well known types of email attachments at the time the invention was made, and that word processing type files could be processed (displayed) by mobile devices while video files could not, due to limitations on processing capabilities at the time.

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to permit these attachments to be received and processed by the system taught by Eggleston and Hall, since they were commonly accepted email attachments at the time the invention was made.

12. Claims 100-102 are rejected under the same rationale as claims 71-73, since they recite substantially identical subject matter. Any differences between the claims do not result in patentably distinct claims and all of the limitations are taught by the above cited art.

13. Claims 66, 74-78, 98, and 103-107 are rejected under 35 U.S.C. 103(a) as being unpatentable over by Eggleston et al. (US 5,958,006 in view of Hall et al. (US 5,826,023) further in view of Official Notice further in view of Kikinis (US 5,964,833).

14. With regard to claims 66 and 74, while the system disclosed by Eggleston and Hall shows substantial features of the claimed invention (discussed above), it fails to disclose receiving a second command message from the mobile data communication device at the host system to send the message attachment to an external device stored in a user profile and redirecting the message attachment from the host system to the external device in response to the second command message.

In a similar messaging system Kikinis disclosed a system that allows users to forward email attachments to various preprogrammed external devices such as a fax machine (Kikinis Col 4, lines 50-56). By allowing users to forward attachments using other devices rather than just email, Kikinis allows users to communicate easier and with more people. For instance an external device such a fax machine may be more convenient for some users or the only form of communication available to other users who are unable to receive email at a particular location.

Therefore, it would have been obvious to one of ordinary skill in the art at the time of Applicant's invention to modify Eggleston's system to allow users to forward attachments to other preprogrammed external devices, as disclosed by Kikinis, so that

Art Unit: 2448

users can communicate with other people by using different means rather than just email and thus communicate with more people.

15. With regard to claim 75, Kikinis disclosed the external device is one of a fax machine (Col 4, lines 50-56).

16. With regard to claim 76, Kikinis disclosed the step of decoupling the message attachment from the e-mail message (i.e. Kikinis only sends the attachment to a fax machine which requires decouple the message attachment from the e-mail message).

17. With regard to claims 77 and 78, Kikinis disclosed the step of storing the e-mail message and message attachment in a message store at the host system (Col 4, lines 38-48).

18. Claims 98 and 103-107 are rejected under the same rationale as claims 66, 74-78, since they recite substantially identical subject matter. Any differences between the claims do not result in patentably distinct claims and all of the limitations are taught by the above cited art.

Conclusion

19. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP

Art Unit: 2448

§ 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to AARON STRANGE whose telephone number is (571)272-3959. The examiner can normally be reached on M-F 8:30-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Firmin Backer can be reached on 571-272-6703. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 2448

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Aaron Strange/
Primary Examiner, Art Unit 2448